

REMARKS

Applicant requests reconsideration and allowance of the subject application. By this Amendment, Applicant has amended claims 1, 2 and 11-13. In the Office Action, the Examiner rejected claims 1-13 under 35 U.S.C. § 103, as allegedly not being patentable over U.S. Patent Application Publication No. 2003/0032417 by *Minear et al.* ("Minear") in view of U.S. Patent Application Publication No. 2004/0076131 by *Qu et al.* ("Qu") and in further view of U.S. Patent No. 6,571,112 to *Ramaswamy*. Applicant traverses this rejection for the reasons set forth below.¹

Preliminary Remarks On Office Action

The rejection of claim 1 refers to a "Ritter" reference but no such reference is applied in the Office Action. Applicant has responded under the assumption that the Examiner intended to rely on *Minear* because the Examiner's citations and arguments are directed to this patent. (Office Action, pp. 2-3.)

In addition, the present Office Action does not address Applicant's argument with regard to *Minear* and *Qu* made in the previous reply filed December 18, 2007. Pursuant to M.P.E.P. § 707.07(f) ("Answer All Material Traversed"), "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The present Office Action essentially repeats the rejection based on *Minear* and *Qu* and adds *Ramaswamy*. However, the Examiner has neither noted Applicant's argument nor answered it. As such, it is respectfully submitted that any subsequent Office Action including a rejection based on the purported combination of *Minear* and *Qu* should not be made final so that Applicant is given a fair opportunity to respond.

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

Furthermore, Applicant has argued that *Minear* and *Qu* do not teach or suggest a "message including a first part identified for installation on the terminal and a second part identified for installation on a chip card accepted in the terminal" (emphasis added), as recited, for example, in claim 11. Similar features are recited in claims 12 and 13. In the Office Action, the Examiner did not respond to this argument nor address this feature in the rejection of claims 11-13. (See Office Action, pp. 2-5.) Accordingly, Applicant respectfully submits that any subsequent Office Action rejecting claims 11-13 based on the purported combination of *Minear*, *Qu* and *Ramaswamy* cannot be made final so that Applicant will have an opportunity to respond to the Examiner's arguments addressing this feature.

Rejection Under 35 U.S.C. § 103(a)

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (See *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); M.P.E.P. 2143.02.) The purported combination of *Minear*, *Qu* and *Ramaswamy* cannot support a rejection of claim 1 under Section 103 because these references do not disclose or suggest, at least, an "application message containing [a] first application part and [a] second formatted application part," as recited in claim 1.

The Examiner concedes that *Minear* does not disclose, amongst other features, an "application message containing [a] first application part and [a] second formatted application part" and "loading the second application part ... from the terminal to the chip card," as recited in claim 1. (Office Action, p. 3.) In fact, *Minear* says nothing with regard to the claimed "chip card." (*Minear*, ¶ 0009.)

Qu is relied on in the Office Action for allegedly teaching "techniques for performing data download to [a] removable module or SIM card via [a] mobile telephone [and] then extract[ing] the application data from the received mobile telephone to the removable module." (Office Action, p. 3, *citing Qu*, ¶¶ 005, 008, 0013, 0024.) *Qu*, however, only discloses loading application data into a removable media, and discards the other data included in a message. (*Qu*, ¶¶ 0067-0069; FIG. 6.) Thus, *Qu* does not disclose or suggest both a "first application part" and a "second formatted application part." It also fails to disclose or suggest "installing in the terminal the first application part extracted from the application message."

Accordingly, taken individually or in combination, *Minear* and *Qu* do not disclose or suggest an "application message" including both a "first application part" and a "second application part." These references, therefore, also cannot disclose or suggest "installing in the terminal the first application part extracted from the application message" and "loading the second application part extracted from the application message from the terminal into the chip card," as recited in claim 1. *Ramaswamy* does not overcome these deficiencies of *Minear* and *Qu*.

Ramaswamy discloses a method for processing an embedded message at a mobile station 106 including a subscriber identity module 108. (*Ramaswamy*, col. 1:44-2:30.) In one embodiment, mobile station 106 receives an encapsulating message 104 which includes a subscriber identity module escape flag 508, and the embedded message 510. (*Id.*) If subscriber identity module escape flag 508 does not indicate a desire to transfer encapsulating message 104 to subscriber identity module 108, mobile station 106 extracts and processes the embedded message 510. (*Id.*)

As best the Office Action can be understood, the Examiner asserts that mobile station 106, subscriber identity module 108, subscriber identity module escape flag 508, and embedded message 510 corresponds to Applicant's claimed "terminal," "chip card,"

"descriptor" and application "part," respectively. But *Ramaswamy* does not disclose the above-noted features of claim 1 missing from *Minear* and *Qu*.

Ramaswamy simply determines whether or not to transfer the encapsulating message 104 to subscriber identity module 108 from mobile station 106. (*Id.* at col. 2:8-11.) That is, the entire encapsulating message 104 is either extracted in mobile device 106 or transferred to subscriber identity module 104. (*Id.*) *Ramaswamy*, therefore, says nothing with regard to dividing encapsulating message 104 or embedded message 510 into more than one "part." Accordingly, *Ramaswamy* fails to disclose or suggest the "application message containing the first application part and the second formatted application part," as recited in claim 1.

Moreover, *Ramaswamy* does not disclose or suggest placing one part of encapsulating message 104 or embedded message 510 in mobile station 106 and another part in subscriber identity module 108. Accordingly, it cannot be considered to disclose or suggest "installing in the terminal the first application part extracted from the application message" and "loading the second application part extracted from the application message from the terminal into the chip card" (emphasis added), as recited in claim 1.

Because *Minear*, *Qu* and *Ramaswamy* fail to disclose or suggest the above-identified features of claim 1, the references, whether taken individually or in combination, with the purported combination of *Minear* and *Qu*, cannot support a rejection of claim 1 under 35 U.S.C. § 103(a).

Furthermore, the applied references cannot support a rejection under Section 103 because one of ordinary skill in the art would have no reason to make the combination purported by the Examiner. There is no nexus between *Minear* and *Qu* that would suggest "installing in the terminal the first application part" and "loading the second application part ... into the chip card," as recited in claim 1.

Qu discards data which is not loaded into a removable media. As such, any combination with *Minear*, in which the data is stored in a phone, would require *Qu* and *Minear* to function differently than they would separately. Indeed, *Qu* tends to teach away from the purported combination with *Minear* for this reason. The purported combination of *Minear* and *Qu* is improper and cannot support a rejection of claim 1 under 35 U.S.C. § 103(a), even if combined with *Ramaswamy*.

The Examiner alleges the purported combination would "provide [for] efficiently download[ing] application data." (Office Action, p. 4.) However, nothing in either reference or the rationale offered by the Examiner suggests that downloading application data to both a cellular telephone and a removable media in the telephone is somehow more efficient. Rather than articulating the reasons for combining *Minear* and *Qu*, the Office Action essentially paraphrases Applicant's own claims. (Office Action, pp. 3-4.) Applicant respectfully submits that the Examiner's only motivation for making the purported combination was based on knowledge gleaned from Applicant's own disclosure. (See, e.g., Office Action, p. 4; Applicant's specification, p. 4:3-14.) Such improper hindsight reconstruction cannot be used to establish a *prima facie* case for rejecting Applicant's claim 1.

For all the reasons above, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed. Claims 2-10 are also allowable over the applied references at least due to their dependence from claim 1.

In addition, claim 2 recites, *inter alia*, "the application message includes a descriptor of the application includes at least one identifier of the second application part, and the management means analyzes the descriptor in the application message received by the terminal so that the second application part is extracted from the application message according to the identifier in the analyzed descriptor" (emphasis added). The Examiner

concedes that *Minear* and *Qu* do not teach a descriptor and extracting a first application part and a second application part from the application message based on the descriptor," as formerly recited in claim 1. (Office Action, p. 4.) Accordingly, *Minear* and *Qu* also do not disclose or suggest the "descriptor" recited in claim 2. *Ramaswamy* does not overcome these deficiencies.

As noted above, *Ramaswamy* simply determines whether or not to transfer the entire encapsulating message 104 to subscriber identity module 108 from mobile station 106. (*Id.* at col. 2:8-11.) *Ramaswamy* says nothing with regard to dividing encapsulating message 104 or embedded message 510 into more than one "application part." Moreover, it does not disclose or suggest placing one part of encapsulating message 104 or embedded message 510 in mobile station 106 and another part in subscriber identity module 108. Accordingly, *Ramaswamy* cannot be considered to disclose or suggest "the application message includes a descriptor of the application includes at least one identifier of the second application part" (emphasis added), as recited in claim 2. Accordingly, claim 2 is allowable over the applied references for this reason as well.

Claims 11-13, although of different scope than claim 1, recite features similar to those recited in claim 1. Thus, claims 11-13 are allowable over the applied references for similar reasons to those set forth above with regard to claim 1. In addition, Applicant submits that neither *Minear* nor *Qu* teaches or suggests a "message including a first part identified for installation on the terminal and a second part identified for installation on a chip card accepted in the terminal" (emphasis added), as recited, for example, in claim 11. Similar features are recited in claims 12 and 13. The Examiner's rejection does not address this feature of claims 11-13 and Applicant cannot otherwise find this feature disclosed in the applied references. Claims 11-13 are, therefore, allowable over the applied references for this reason as well.

Conclusion

For the reasons set forth above, Applicant respectfully requests allowance of the pending claims.

If additional fees are required for any reason, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

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